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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,114	09/04/2001	Christopher Andrew Barton	550-260	2442

7590 08/03/2004

NIXON & VANDERHYE P.C.
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EXAMINER

MITCHELL, JASON D

ART UNIT PAPER NUMBER

2124

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,114

Applicant(s)

BARTON ET AL.

Examiner

Jason Mitchell

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/04/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application is a Continuation In Part of U.S. application # 09/633,358 filed on 08/04/2000
2. Claims 1-30 are pending in the application

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "64" has been used to designate both "a display" and "a user input/output driver". Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to because Internet 2 is not labeled with a reference character (2) in Figures 2,3 and 5. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and

where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:
- Page 12, line 5 "a system in which a system sends" It is believed this should read "a system in which Server 4 sends".
 - Page 12, line 19 "Accordingly, in accordance with"
 - Page 18, line 10 "[Figure 7]" should be removed.

Applicant should inspect the specification for other similar issues that may not have been mentioned. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11-20 recite a computer program

product to trigger updating of a computer file, but fails to recite a tangible medium to support the program in order to accomplish the steps leading to a useful result. Absent a computer-readable medium the computer program product as described cannot be implemented therefore no result can be achieved. Hence the set of claims 11-20 do not fulfill the requirements of statutory subject matter. Appropriate action is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1,2,4,7,8-10, 11,12,14,17,18-20, 21,22,24,27,28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN: 6,151,643 to Cheng et al. (Cheng)

Regarding Claims 1, 11 and 21: Cheng teaches a method, computer program product, and apparatus providing an updated version of a computer file at a location from which it may be downloaded (col. 3, lines 14-15), and sending a tag (col. 20 line 2 'record from the update table') indicative of availability of said updated computer file.

Regarding Claims 2, 12 and 22: The rejection of Claim 1 is incorporated; further Cheng teaches sending said tag as part of an e-mail message. (col. 19, lines 61-63)

Regarding Claims 4, 14 and 24: The rejection of Claim 1 is incorporated; further Cheng teaches a connection to said location via an Internet link. (col. 3, lines 13-15)

Regarding Claims 7, 17 and 27: The rejection of Claim 1 is incorporated; further Cheng teaches that said tag contains data indicative of a version level. (col. 4 lines 54-59)

Regarding Claims 8, 18 and 28: The rejection of Claim 1 is incorporated; further Cheng teaches maintaining a database (col. 17, lines 4-5) of computers to which said tag is to be sent.

Regarding Claims 9, 19 and 29: The rejection of Claim 8 is incorporated; further Cheng teaches that said database includes priority data (col. 20, lines 47-49), said priority level being used to control how rapidly after said updated version of said computer file is made available said tag is sent. In Cheng's teachings there are only 2 priority levels, send now and send never, however this is still considered a priority list under it's broadest definition.

Regarding Claims 10, 20 and 30: The rejection of Claim 1 is incorporated; further Cheng teaches a method, computer program product and apparatus wherein sending of said tag upon availability of an updated version of said computer file is provided as a subscription service. (col. 5, lines 22-23)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al, USPN: 6,151,643 (Cheng), in view of Neal, USPN: 6,192,518 (Neal).

Regarding Claims 3, 13 and 23: The rejection of Claim 2 is incorporated; further Cheng does not teach including said tag as part of an e-mail header. Cheng's invention requires users to manually connect to the server in order to receive the updated file.

This would be greatly improved by the automatic updating described in Neal.

Neal teaches that said tag is part of an e-mail message header. (col. 5, lines 11-13)

Neal discloses placing the tag, in this case prefaced by the text "MBA 2.0" in the e-mail's subject line, enabling an application running on the client to scan the in-box (See fig. 2a, 210) and automatically detect the notification of the update's availability. Once detected, the client application initiates the retrieval and update process.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide each of Cheng's client computers with the automatic detection and response (col. 5, lines 9-13) aspects of Neal's invention, thereby removing any reliance on users to perform the updates in a timely manner and ensuring uniformity on the client side as is desirable. (Neal col. 2 lines 25-30)

11. Claims 5, 6, 15, 16, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng as applied to claims 1, 2, 4, 7, 8-10, 11, 12, 14, 17, 18-20, 21, 22, 24, 27, 28-30 above, in view of Hodges et al, USPN: 6,035,423 (Hodges).

Regarding Claims 5, 6, 15, 16, 25, and 26: The rejection of claim 1 is incorporated; further, Cheng does not teach using his invention to update anti-virus software, but does state the scope of products that could be updated as “various software products” (See Cheng col. 25, lines 15-17), and antivirus software as described in Hodges certainly falls within this range.

Hodges teaches a method, computer program product and apparatus for the updating of virus definition data, and anti-virus computer programs. (See Hodges Fig 7) Further, Hodges notes that it is desirable to provide a method for providing the most up-to-date virus files to a client (col. 4, 26-39)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Cheng's software updating method to ensure that clients had the most up-to-date anti-virus software installed as discussed in Hodges (See col. 4, lines 26-39). The modification would have been obvious because one of ordinary skill in the art would have been motivated to use Cheng's methods to ensure that users had timely notification of availability of an anti-virus software update (Hodges col. 3, lines 30-31) such as that disclosed by Hodges.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (703) 305-0064. The examiner can normally be reached Monday-Friday 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703) 305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Mitchell
July 2, 2004

A handwritten signature in black ink, appearing to read "John Chavis", with a long horizontal flourish extending to the right.

JOHN CHAVIS
PATENT EXAMINER
ART UNIT 2124